

which would lead a person skilled in the art to suspect that this concentration step was unnecessary. For the foregoing reasons, Applicant submits that claim 1 and all the claims dependent thereon are allowable over the '508 patent.

The Examiner rejected claims 3 and 6-15 under 35 USC § 103 as obvious over the '508 patent. The Examiner asserts that "it would have been obvious ... to employ flagellates other than *T. rostratus*, because in view of the teachings of Jaffe, one would have a high expectation of success in employing any known flagellate with the requisite qualities taught in the present specification." Conversely, the Examiner also rejected claims 1, 4, 7, 8 and 15 under 35 USC § 112, first paragraph, arguing that while the application provides enablement for the enumerated flagellates, it does not provide enablement for any and all flagellates. Thus, the Examiner has apparently arrived at the conclusion that the person skilled in the art can simply look at the '508 patent and divine the specific list of flagellates other than *T. rostratus* as being ones expected to work, and at the same time asserts that this selection would require undue experimentation. These two arguments are wholly inconsistent and cannot both be maintained.

It should further be noted that the Examiner has utterly failed to provide support for the rejection under 35 USC § 112, first paragraph, of the type which is required by applicable case law. This standard is set forth in *In re Marzocchi*, 169 USPQ 367, 369, where the CCPA held that:

a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112, *unless* there is a reason to doubt the objective truth of the statements contained therein, which must be relied upon for an enabling disclosure.

See also, *In re Bowen*, 181 USPQ 48 (CCPA 1974); *In re Strahilevitz*, 212 U.S.P.Q. 561 (C.C.P.A. 1982); What the Examiner has done instead is to make a plethora of unsupported statements. This is not sufficient, as the Applicant cannot meaningfully counter the Examiner's arguments if the underlying reasoning is not provided. Thus, the rejection should either be withdrawn or a complete rejection made in a new, **non-final** Office Action.

Looking at the individual statements made by the Examiner makes the inadequacy of the rejection clear. The first statement made by the Examiner is that “the terms ‘a particle feeding flagellate’ lack enablement as it would require one of ordinary skill in this art undue experimentation to determine which such flagellate would work in the instant invention.” No reasons have been offered, however, to support the underlying premise that not all particle feeding flagellates will work. Furthermore, the assertion regarding skill in the art is inconsistent with the rejection under 35 USC § 103.

The Examiner also asserts that the quantity of experimentation necessary would be undue because of the large proportion of inoperative organisms. Again, no support is provided for the supposition that there is a large proportion of inoperative organisms, and the rejection is therefore incomplete. *In re Dinh-Nguyen*, 181 USPQ 46, 48 (CCPA 1974). Furthermore, it should be noted that exclusion of inoperative species is not required where a person skilled in the art would recognize them as such. *In re Anderson*, 176 USPQ 331 (CCPA 1973) In this case, the Examiner has, in his § 103 rejection, asserted a skill level which presumes such recognition an ability.

Moreover, even if there are some particle feeding flagellates which will not work in the invention, the amount of testing required to determine this can hardly be termed undue experimentation. The procedures for the analysis are disclosed. To see if a particular, non-enumerated particle feeding flagellate works, one simply runs the test and sees if results are obtained comparable to *T. rostratus* or some other standard.

The Examiner also states that the working examples are for only specific flagellates, “and extension to other flagellates has not been specifically taught or suggested.” Applicant respectfully submits that this statement is simply wrong. The application clearly states the generic concept of using particle feeding flagellates (Page 4, lines 7-9). Further, the extension of the specific examples to other species is plainly stated on Page 4, lines 18-21).

The Examiner also asserts that the “state of the prior art indicates that most related flagellates are not effective for the claimed function.” If this were the case, then the rejection under 35 USC § 103 of claims 3 and 6-15 would be manifestly unsupportable. However, the

Examiner has not identified what prior art he is referring to. Absent such an identification, this statement is unsupported and cannot be relied upon as a basis for the rejection.

The Examiner also asserts that the claims encompass an innumerable number of organisms, but he has not identified a single particle feeding flagellate which is not specifically named in the claims. If he did so, and explained why he had doubts about the operability of the species, Applicant could provide a meaningful response, for example by testing the organism or challenging the logic underlying the assertion of inoperability. That he has not done so if evidence that the rejection is really one of "not enough examples" rather than any real lack of enablement. Since no examples are required to meet the enablement requirement, however, an argument premised on nothing more than "not enough examples" is plainly in error.

The examiner also rejected claims 1, 2, 4 and 5-15 under 35 USC § 112, first paragraph, reciting the written description language of this paragraph of the statute. This rejection is based on an asserted inconsistency between statements of pages 4 and 6 of the application. Applicant respectfully submits that there is no inconsistency. Page 4 of the application provides the person skilled in the art with the information that *T. rostratus* is not well suited for analysis of marine samples because it dies in conditions of 10% sea water. Page 6 states that "**a living culture of *T. rostratus* or other suitable organism as discussed above**" is combined with a whole effluent sample. Some of the samples enumerated are marine samples with which *T. rostratus* will not work well. The person skilled in the art, however, will know from the teaching on Page 4, that this sentence does not mean that all organisms will work for all samples, or will work equally well for all samples, and would not understand this passage to retract the language of page 4. Thus, Applicant submits that the rejection under 35 USC § 112, first paragraph should be withdrawn.

Finally, the Examiner rejected claims 1-15 under 35 USC § 112, second paragraph. Claim 1 has been amended in view of the Examiner's remarks. Applicant respectfully submits that the grammar in Claim 7 is correct in the form presented and has therefore not amended the claim. In the event the Examiner has a reason to believe that a persons

skilled in the art would not understand the scope of the claim, the reasoning underlying this belief is requested.

With respect to claim 15, Applicant has amended the specification to include the language of claim 15. Applicant does not understand, however, the basis for the assertion of indefiniteness. The claim does not require that the flagellates of the two cultures be different in size for any particular reason. It simply requires that two cultures with different mean flagellate sizes be used and the results compared. The Examiner has not explained why a person skilled in the art would have difficulty knowing if they were performing such a process. Thus, he has failed to put forth a valid rejection under 35 USC § 112, second paragraph. *In re Cordova*, 10 U.S.P.Q. 2d 1949 (POBAI 1989).

For the foregoing reasons, Applicant submits that this application is now in form for allowance. Favorable reconsideration and allowance of all claims are respectfully urged.

Respectfully submitted,


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